

ESTTA Tracking number: **ESTTA628175**Filing date: **09/19/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	South Cone, Inc.		
Entity	Corporation	Citizenship	California
Address	5935 Darwin Court Carlsbad, CA 92008 UNITED STATES		

Attorney information	Brooks R. Bruneau Porzio, Bromberg & Newman 29 Thanet Road Suite 201 Princeton, NJ 08540 UNITED STATES brbruneau@pbnlaw.com Phone:509 924-8555
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Registration Subject to Cancellation

Registration No	4513118	Registration date	04/15/2014
International Registration No.	NONE	International Registration Date	NONE
Registrant	JUN Co., Ltd. 2-3, Minamiaoyama 2-chome JAPAN		

Goods/Services Subject to Cancellation

Class 025. First Use: 0 First Use In Commerce: 0


All goods and services in the class are cancelled, namely: Overcoats, topcoats, raincoats, suits, dresses, jackets, vests and waistcoats, jumpers, trousers, skirts, jeans, fur coats, fur vests, leather coats, leather jackets, leather pants, leather suits, leather jumpsuits, school uniforms, evening dresses and dinner jackets; sweaters, pullovers, cardigans, shirts for suits, blouses, sport shirts, polo shirts and t-shirts; underwear, namely, undershirts, shorts, briefs, corsets, brassieres, girdles, petticoats, and camisoles; nightwear, namely, pajamas, night gowns, negligees and bath robes; bathing wear, namely, swimming pants, swimming suits and swimming caps; Japanese traditional outerwear, namely, kimonos; Japanese traditional home wear, namely, yukata; Japanese sash bands for kimono and yukata, namely, obi; undershirts for kimono (juban); ties, bow ties, stockings not for sports, socks, shawls, bandanas, neckerchiefs, scarves, fur stoles, ear muffs and gloves; headgear, namely, hats and caps, visors, hats of fur, headwear in the nature of night caps and shower caps; garters, sock suspenders, suspenders, waistbands and belts for clothing; footwear other than special footwear for sports, namely, shoes, boots, sneakers, sandals and beach sandals; slippers, Japanese style sandals (zori), and Japanese style wooden clogs (geta); masquerade costumes


Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)


Dilution	Trademark Act section 43(c)
Other	No bona fide intention to use the mark in Class 25. Section 1(b)


Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2418438	Application Date	07/01/1999
Registration Date	01/02/2001	Foreign Priority Date	NONE
Word Mark	REEF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/06/00 First Use In Commerce: 1999/06/00 Swimwear		


U.S. Registration No.	2244373	Application Date	10/28/1997
Registration Date	05/11/1999	Foreign Priority Date	NONE
Word Mark	REEF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 footwear, shoes and clothing namely, shirts, shorts, jackets [gloves,] and sweat-shirts [mittens, scarves and pants]		


U.S. Registration No.	3599030	Application Date	01/09/2007
Registration Date	03/31/2009	Foreign Priority	NONE

		Date	
Word Mark	REEF		
Design Mark			
Description of Mark	The mark consists of a fanciful floral design element to the left of the literal portion of the mark.		
Goods/Services	Class 025. First use: First Use: 2007/07/15 First Use In Commerce: 2007/07/15 Bathing suits; Bikinis; Blouses; Boardshorts; Boxer shorts; Fleece shorts; Footwear; Headwear; Jackets; Jeans; Muscle tops; Pants; Sandals; Sarongs; Shirts; Shoes; Shorts; Skirts; Swim trunks; Swim wear; T-shirts; Walking shorts		


U.S. Registration No.	2315934	Application Date	09/24/1998
Registration Date	02/08/2000	Foreign Priority Date	NONE
Word Mark	REEF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/07/00 First Use In Commerce: 1998/07/00 Footwear and shoes		

U.S. Registration No.	3432642	Application Date	12/19/2004
Registration Date	05/20/2008	Foreign Priority Date	NONE
Word Mark	REEF CLOTHING		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2007/08/15 First Use In Commerce: 2007/08/15 Clothing, namely, shorts, walking shorts, board shorts, boxers, pants, jeans, swimming trunks, bathing suits, bikinis, skirts, sarongs, shirts, blouses, t-shirts, jackets, fleeces, muscle shirts; footwear and headwear

U.S. Registration No.	3441554	Application Date	01/09/2007
Registration Date	06/03/2008	Foreign Priority Date	NONE
Word Mark	REEF REDEMPTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2007/10/01 First Use In Commerce: 2007/10/01 Bathing suits; Bikinis; Blouses; Boardshorts; Boxer shorts; Fleece shorts; Footwear; Headwear; Jackets; Jeans; Muscle tops; Pants; Sandals; Sarongs; Shirts; Shoes; Shorts; Skirts; Swim trunks; Swim wear; T-shirts; Walking shorts Class 036. First use: First Use: 2007/10/01 First Use In Commerce: 2007/10/01 Charitable fund raising		

U.S. Registration No.	3606488	Application Date	01/22/2007
Registration Date	04/14/2009	Foreign Priority Date	NONE
Word Mark	REEF REDEMPTION		

Design Mark	
Description of Mark	The mark consists of a fanciful rendition of the literal element with a cross appearing within the letter "o". The wording "REEF REDEMPTION" is written in the color green; the letter "O" in "REDEMPTION" contains a cross consisting of a blue vertical line and a green horizontal line.
Goods/Services	Class 025. First use: First Use: 2007/06/01 First Use In Commerce: 2007/10/01 Bathing suits; Bikinis; Blouses; Boardshorts; Boxer shorts; Fleece shorts; Footwear; Headwear; Jackets; Jeans; Muscle tops; Pants; Sandals; Sarongs; Shirts; Shoes; Shorts; Skirts; Swim trunks; Swim wear; T-shirts; Walking shorts Class 036. First use: First Use: 2007/06/01 First Use In Commerce: 2007/09/07 Charitable fund raising

Attachments	75741136#TMSN.png(bytes) 75380476#TMSN.png(bytes) 77079415#TMSN.png(bytes) 75559112#TMSN.png(bytes) 78535125#TMSN.png(bytes) 77079405#TMSN.png(bytes) 77088341#TMSN.png(bytes) Petition_for_Cancellation.PDF(216931 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/brooks r. bruneau/
Name	Brooks R. Bruneau
Date	09/19/2014

SOUTH CONE, INC.	:	
	:	
Petitioner,	:	Cancellation No.:
	:	
Vs.	:	Registration No. 4,513,118
	:	Filing Date: August 22, 2012
JUN Co., Ltd .	:	Registration Date: April 15, 2014
	:	Mark: REEFUR (Stylized lettering)
Respondent.	:	
	:	
	:	

South Cone, Inc., d/b/a Reef, with a mailing address of 5935 Darwin Court, Carlsbad, California 92008 (hereinafter "Petitioner"), believes it is being damaged by the registration of the mark "REEFUR" (stylized lettering), registered in connection with the following Class 25 goods:

2847937

As set forth in Registration No. 4,513,118 filed August 22, 2012 and registered on April 15, 2014, and hereby petitions the Trademark Trial and Appeal Board to cancel said registration.

As grounds for this Petition to Cancel, it is alleged that:


1. Respondent's REEFUR (stylized) registration includes the following goods in Class 25:


Overcoats, topcoats, raincoats, suits, dresses, jackets, vests and waistcoats, jumpers, trousers, skirts, jeans, fur coats, fur vests, leather coats, leather jackets, leather pants, leather suits, leather jumpsuits, school uniforms, evening dresses and dinner jackets; tuxedos; sweaters, pullovers, cardigans, shirts for suits, blouses, sport shirts, polo shirts and t-shirts; underwear, namely, undershirts, shorts, briefs, corsets, brassieres, girdles, petticoats, and camisoles; nightwear, namely, pajamas, night gowns, negligees and bath robes; bathing wear, namely, swimming pants, swimming suits and swimming caps; Japanese traditional outerwear, namely, kimonos; Japanese traditional home wear, namely, yukata; Japanese sash bands for kimono and yukata, namely, obi; undershirts for kimono (juban); ties, bow ties, stockings not for sports, socks, shawls, bandanas, neckerchiefs, scarves, fur stoles, ear muffs and gloves; headgear, namely, hats and caps, visors, hats of fur, headwear in the nature of night caps and shower caps; garters, sock suspenders, suspenders, waistbands and belts for clothing; footwear other than special footwear for sports, namely, shoes, boots, sneakers, sandals and beach sandals; slippers, Japanese style sandals (zori), and Japanese style wooden clogs (geta); masquerade costumes.

These Class 25 goods are hereinafter referred to as "Respondent's Goods".

2. Prior to the August 31, 2012 filing date of the REEFUR application, Petitioner established rights in its multiple REEF trademarks pursuant to the following United States Trademark Registrations:

MARK	REGISTRATION NO.	APPLICATION NO.	GOODS
REEF	2,418,438	75-741136	Swimwear
REEF	2,244,373	75-380476	(Int'l Class: 25) Footwear, shoes

			and clothing namely, shirts, shorts, jackets [gloves,] and sweatshirts [mittens, scarves and pants]
REEF and Design 	3,599,030	77-079415	Bathing suits; bikinis; blouses; boardshorts; boxer shorts; fleece shorts; footwear; headwear; jackets; jeans; muscle tops; pants; sandals; sarongs; shirts; shoes; shorts; skirts; swim trunks; swim wear; t-shirts; walking shorts
REEF and Design 	2,315,934	75-559112	Footwear and shoes
REEF CLOTHING	3,432,642	78-535125	(Int'l Class: 25) Clothing, namely, shorts, walking shorts, board shorts, boxers, pants, jeans, swimming trunks, bathing suits, bikinis, skirts, sarongs, shirts, blouses, t- shirts, jackets, fleeces, muscle shirts; footwear and headwear
REEF REDEMPTION REEF REDEMPTION	3,441,554	77-079405	(Int'l Class: 25) Bathing suits; bikinis; blouses; boardshorts; boxer shorts; fleece shorts; footwear; headwear; jackets; jeans; muscle tops; pants; sandals; sarongs; shirts; shoes; shorts;

			skirts; swim trunks; swim wear; t-shirts; walking shorts (Int'l Class: 36) Charitable fund raising
REEF REDEMPTION and Design 	3,606,488	77-088341	Bathing suits; bikinis; blouses; boardshorts; boxer shorts; fleece shorts; footwear; headwear; jackets; jeans; muscle tops; pants; sandals; sarongs; shirts; shoes; shorts; skirts; swim trunks; swim wear, t-shirts walking shorts (Int'l Class: 36) Charitable fund raising

The above captioned U.S. Trademark Registrations are hereinafter referred to as the "REEF Marks."

3. Petitioner's rights in the REEF Marks were first registered on January 30, 1996 with dates of first use extending back to 1988.

4. Petitioner's registrations for its REEF Marks are valid. Moreover, U.S. Registration Nos. 2,315,934; 2,418,438; and 2,244,373 are incontestable under Trademark Act Section 15.

COUNT ONE

5. Petitioner repeats and realleges the statements and allegations as set forth above as if fully set forth in this Count.

6. Respondent has registered its REEFUR trademark in connection with a variety of clothing articles that include casual clothing articles such as "t-shirts, bathing wear, namely, swimming pants, swimming suits and swimming caps, footwear, other than special footwear for sports, namely, shoes, boots, sneakers, sandals and beach sandals; slippers."

7. The Respondent has adopted the REEF mark of Petitioner and merely added "UR" to the end, creating the derivative term "REEFUR."

8. The Respondent applied to register its REEFUR trademark based upon Section 66(a), with intent to use, but may have had no bona fide intention to use the mark in commerce at time of filing.

9. There is no doubt as to seniority in this case. Petitioner's use and registration of its REEF Marks in Class 25 predates Respondent's application and registration by years.

10. Use of the REEFUR trademark by Respondent in connection with clothing articles at the same time Petitioner is utilizing its REEF Marks in connection with the same or related clothing goods is likely to cause confusion or to cause mistake and deception in the industry and among purchasers, and potential purchasers of Petitioner's goods offered under its REEF Marks resulting in damage to Petitioner.

11. Because of the confusing similarity between Respondent's mark and Petitioner's REEF Marks, Petitioner's long and extensive use of its REEF Marks in connection with goods in Class 25, along with the identical and similar nature of Respondent's goods to be offered under its REEFUR trademark, such use by Respondent is likely to cause consumers to believe that Respondent's goods are those of Petitioner or are otherwise endorses, sponsored by, licensed by or approved by Petitioner, causing damage to Petitioner. Moreover, any false, disappointment, complaints or other dissatisfaction a consumer might experience by using the Respondent's goods would inure to the detriment of Petitioner.

COUNT TWO

12. Petitioner repeats and realleges the statements and allegations set forth above as if fully set forth in this Count.

13. Petitioner uses its REEF Marks to market its goods and services to various businesses and distributors, and has engaged in extensive advertising and promotional efforts. By virtue of its efforts, and the expenditure of considerable sums for promotional activities, as well as the excellence of the quality of its goods and services, Petitioner has gained a valuable reputation and good will through use of its REEF Marks. By virtue of Petitioner's efforts and excellence of its goods and services, the REEF Marks have become famous. Accordingly, use of REEFUR will dilute the distinct and famous nature of Petitioner's REEF Marks in violation of §43(c) of the U.S. Trademark Act.

CONCLUSION

14. Respondent's registration of REEFUR in connection with the Respondent's Goods will cause confusion and mistake, or deceive consumers and the industry as to the source of the goods and services bearing the REEFUR mark, as well as the source of the goods offered under Petitioner's REEF Marks. Such registration will handicap and damage the legitimate present and future activities of Petitioner by placing Respondent in a position to raise doubts as to the rights of Petitioner to use its REEF Marks in connection with the goods identified in its U.S. registrations set forth above. Should the registration herein challenged in Class 25 be maintained, Respondent will have a presumptive right to use that trademark for the listed class 25 goods, and such use of the REEFUR mark would blur the identification of Petitioner as a source of its products bearing its REEF Marks, and tarnish the association with which said mark

has come to convey. As a result, Petitioner will eventually be deprived of all distinctiveness in its REEF Marks.

WHEREFORE, South Cone, Inc. requests that Class 25 in U.S. Registration of 4,513,118 be cancelled.

Respectfully submitted:

SOUTH CONE, INC.

Date: 9/19/2014

BY: Brooks R. Bruneau

Brooks R. Bruneau
Attorney for Petitioner
PORZIO, BROMBERG & NEWMAN, PC
29 Thanet Road, Suite 201
Princeton, NJ 08540
Tel: 609-924-8555

CERTIFICATE OF ELECTRONIC FILING

I hereby certify this Petition to Cancel was electronically filed with the Trademark Trial and Appeal Board this 19th day of Sept., 2014.

Brooks R. Bruneau
(Signature)
9/19/2014
(Date of Signature)

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Petition to Cancel was served upon counsel of record listed below, via First Class Mail, Postage Prepaid, on this 19th day of Sept., 2014, addressed to:

Joan Optican Herman, Esq.
Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
84 Corporate Woods
Overland Park, KS 66210

Dated: 9/19/2014

By: Brooks R. Bruneau
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